

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

December 2, 2007

In re application of David L. Kaminsky, et al.

Serial No.: 10/654,786 Filed: September 4, 2003

For: Policy-Based Management of Instant Message Windows

Art Unit: 2155 Examiner: Kevin T. Bates

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
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Sir:

This is a Response to the Notification of Non-Compliant Appeal Brief mailed November 29, 2007, which stated that the Summary of Claimed Subject Matter is defective in Appellants' Appeal Brief filed on November 13, 2007 (hereinafter, "Appellants' previously-filed Appeal Brief"). In accordance with MPEP §1205.03, titled "Non-Compliant Appeal Brief and Amended Brief", a replacement **SUMMARY OF CLAIMED SUBJECT MATTER** is provided herewith, and this replacement **SUMMARY** should be substituted for paragraphs 1 - 7 of Appellants' previously-filed Appeal Brief.

## 5) SUMMARY OF CLAIMED SUBJECT MATTER

1. Appellants' independent Claim 1 is a method claim directed toward instant messaging, and in particular, using policy information in responding to arrival of instant messages (Claim 1, line 1; Specification, p. 6, lines 9 - 10). An instant messaging ("IM") user defines policy information comprising criteria for responding to arrival of instant messages (Claim 1, lines 3 - 4; Specification, p. 11, lines 1 - 2). In particular, the policy comprises a list of application programs (other than the IM application itself) that are executable on the IM user's computing device (Claim 1, lines 4 - 6; Specification, p. 12, lines 1 - 2 and lines 7 - 9). If an instant message arrives (Claim 1, lines 7 - 8), the policy is used to determine whether or not a new IM window is opened for displaying that newly-arriving instant message (Claim 1, lines 9 - 16; Specification, p. 20, lines 12 - 15; see also Specification, p. 6, lines 11 - 12 and p. 7, lines 2 - 3). In particular, this comprises determining whether any of the applications from the list are currently executing (Claim 1, lines 9 - 10; Specification, p. 12, lines 7 - 9); if none of the applications is executing, then the newly-arriving instant message is displayed in a new window (Claim 1, lines 12 - 14, for the "negative result" case; Specification, p. 12, lines 7 - 9), but if any of those applications is/are executing, then instead of opening a new window, an icon representing this message is added to an already-open window (Claim 1, lines 14 - 16, for the "positive result" case ; Specification, p. 12, lines 7 - 9 and p. 17, lines 16 - 18; see also paras. 3 - 4, below).

2. Claim 1 further states that the newly-received instant message is from an IM sender who is not already participating in an IM session with the (recipient) user (Claim 1, lines 7 - 8). Newly-arriving messages from such already-participating IM senders will be displayed in the already-

open window for that IM session (Specification, p. 11, lines 16 - 19), and thus are outside the scope of the present invention as claimed in Claim 1.

3. In addition to the functionality discussed above in paragraph 1, Claim 1 further specifies that the already-open window to which an icon is added (i.e., in the case where an application or applications from the list is/are currently executing) comprises an already-open buddy list window that visually depicts a list of the IM partners from an IM address book (Claim 1, lines 17 - 18), or an already-open status window that visually depicts a list of each currently-active IM partner (Claim 1, lines 19 - 20). In this manner, the “visual clutter” that results using a prior art approach – where a new window opens for each new IM session – may be avoided when using the present invention (Specification, p. 12, lines 18 - 19). The user may also experience less distraction by having fewer IM windows popping up on his display when using the present invention. Specification, p. 12, lines 18 - 21. See, for example, **Figs. 1 - 3**. In contrast to the cluttered display **100** of **Fig. 1**, where a prior art approach pops up new windows illustrated at **120, 130, and 150** for each new IM session, **Fig. 2** illustrates the display of icons in an already-open window **200** according to the present invention, where these icons are placed in already-open window **200** because an instant message arrives while any of the listed applications is/are executing. Specification, p. 12, lines 18 - 21. **Fig. 3** shows an alternative approach to window **200**, where icons **300, 310** of **Fig. 3** are added to an already-displayed buddy list or status window that lists several IM partners and partner groups (Specification, p. 13, lines 1 - 4).

4. Claim 1 further states that the icon that is added to the already-open window is added in

association with a representation of the IM sender (i.e., the sender of the newly-arriving instant message which caused the icon to be added; Claim 1, lines 21 - 22; Specification, p. 17, lines 16 - 18), and that this icon visually indicates that the instant message is available for on-request display and can be activated to cause this on-request display (Claim 1, lines 23 - 24; Specification, p. 12, lines 15 - 18 and p. 13, lines 14 - 15). See **Figs. 2 and 3**, where the icons are shaped as an envelope and are depicted “in association with” a name of the instant message sender.

5. Independent Claims 28 and 29 are system and computer program product claims, respectively, which specify limitations analogous to those of Claim 1 and therefore find support in the same, above-cited portions of Appellants’ specification. The above-presented paragraphs 1 - 4 which discuss independent Claim 1 are repeated below as paragraphs 5.1.1 - 5.1.4, where they are updated to refer to the analogous limitations of independent Claim 28, and again as paragraphs 5.2.1 - 5.2.4, where they are updated to refer to the analogous limitations of independent Claim 29.

5.1.1 Appellants’ independent Claim 28 is a system claim directed toward instant messaging, and in particular, using policy information in responding to arrival of instant messages (Claim 28, line 1; Specification, p. 6, lines 9 - 10). An IM user defines policy information comprising criteria for responding to arrival of instant messages (Claim 28, lines 3 - 4; Specification, p. 11, lines 1 - 2). In particular, the policy comprises a list of application programs (other than the IM application itself) that are executable on the IM user’s computing device (Claim 28, lines 4 - 7; Specification, p. 12, lines 1 - 2 and lines 7 - 9). If an instant message arrives (Claim 28, lines 8 -

9), the policy is used to determine whether or not a new IM window is opened for displaying that newly-arriving instant message (Claim 28, lines 10 - 17; Specification, p. 20, lines 12 - 15; see also Specification, p. 6, lines 11 - 12 and p. 7, lines 2 - 3). In particular, this comprises determining whether any of the applications from the list are currently executing (Claim 28, lines 10 - 12; Specification, p. 12, lines 7 - 9); if none of the applications is executing, then the newly-arriving instant message is displayed in a new window (Claim 28, lines 13 - 15, for the “negative result” case; Specification, p. 12, lines 7 - 9), but if any of those applications is/are executing, then instead of opening a new window, an icon representing this message is added to an already-open window (Claim 28, lines 15 - 17, for the “positive result” case ; Specification, p. 12, lines 7 - 9 and p. 17, lines 16 - 18; see also paras. 3 - 4, below).

5.1.2. Claim 28 further states that the newly-received instant message is from an IM sender who is not already participating in an IM session with the (recipient) user (Claim 28, lines 8 - 9). Newly-arriving messages from such already-participating IM senders will be displayed in the already-open window for that IM session (Specification, p. 11, lines 16 - 19), and thus are outside the scope of the present invention as claimed in Claim 28.

5.1.3. In addition to the functionality discussed above in paragraph 5.1.1, Claim 28 further specifies that the already-open window to which an icon is added (i.e., in the case where an application or applications from the list is/are currently executing) comprises an already-open buddy list window that visually depicts a list of the IM partners from an IM address book (Claim 28, lines 19 - 20), or an already-open status window that visually depicts a list of each currently-

active IM partner (Claim 28, lines 21 - 22). In this manner, the “visual clutter” that results using a prior art approach – where a new window opens for each new IM session – may be avoided when using the present invention (Specification, p. 12, lines 18 - 19). The user may also experience less distraction by having fewer IM windows popping up on his display when using the present invention. Specification, p. 12, lines 18 - 21. See, for example, **Figs. 1 - 3**. In contrast to the cluttered display **100** of **Fig. 1**, where a prior art approach pops up new windows illustrated at **120, 130**, and **150** for each new IM session, **Fig. 2** illustrates the display of icons in an already-open window **200** according to the present invention, where these icons are placed in already-open window **200** because an instant message arrives while any of the listed applications is/are executing. Specification, p. 12, lines 18 - 21. **Fig. 3** shows an alternative approach to window **200**, where icons **300, 310** of **Fig. 3** are added to an already-displayed buddy list or status window that lists several IM partners and partner groups (Specification, p. 13, lines 1 - 4).

5.1.4. Claim 28 further states that the icon that is added to the already-open window is added in association with a representation of the IM sender (i.e., the sender of the newly-arriving instant message which caused the icon to be added; Claim 28, lines 23 - 24; Specification, p. 17, lines 16 - 18), and that this icon visually indicates that the instant message is available for on-request display and can be activated to cause this on-request display (Claim 28, lines 25 - 27; Specification, p. 12, lines 15 - 18 and p. 13, lines 14 - 15). See **Figs. 2** and **3**, where the icons are shaped as an envelope and are depicted “in association with” a name of the instant message sender.

5.2.1 Appellants' independent Claim 29 is a computer program product claim directed toward instant messaging, and in particular, using policy information in responding to arrival of instant messages (Claim 29, lines 1 - 2; Specification, p. 6, lines 9 - 10). An IM user defines policy information comprising criteria for responding to arrival of instant messages (Claim 29, lines 4 - 5; Specification, p. 11, lines 1 - 2). In particular, the policy comprises a list of application programs (other than the IM application itself) that are executable on the IM user's computing device (Claim 29, lines 5 - 8; Specification, p. 12, lines 1 - 2 and lines 7 - 9). If an instant message arrives (Claim 29, lines 9 - 10), the policy is used to determine whether or not a new IM window is opened for displaying that newly-arriving instant message (Claim 29, lines 11 - 20; Specification, p. 20, lines 12 - 15; see also Specification, p. 6, lines 11 - 12 and p. 7, lines 2 - 3). In particular, this comprises determining whether any of the applications from the list are currently executing (Claim 29, lines 11 - 13; Specification, p. 12, lines 7 - 9); if none of the applications is executing, then the newly-arriving instant message is displayed in a new window (Claim 29, lines 15 - 18, for the "negative result" case; Specification, p. 12, lines 7 - 9), but if any of those applications is/are executing, then instead of opening a new window, an icon representing this message is added to an already-open window (Claim 29, lines 18 - 20, for the "positive result" case ; Specification, p. 12, lines 7 - 9 and p. 17, lines 16 - 18; see also paras. 3 - 4, below).

5.2.2. Claim 29 further states that the newly-received instant message is from an IM sender who is not already participating in an IM session with the (recipient) user (Claim 29, lines 9 - 10). Newly-arriving messages from such already-participating IM senders will be displayed in the already-open window for that IM session (Specification, p. 11, lines 16 - 19), and thus are outside

the scope of the present invention as claimed in Claim 29.

5.2.3. In addition to the functionality discussed above in paragraph 5.2.1, Claim 29 further specifies that the already-open window to which an icon is added (i.e., in the case where an application or applications from the list is/are currently executing) comprises an already-open buddy list window that visually depicts a list of the IM partners from an IM address book (Claim 29, lines 22 - 23), or an already-open status window that visually depicts a list of each currently-active IM partner (Claim 29, lines 24 - 25). In this manner, the “visual clutter” that results using a prior art approach – where a new window opens for each new IM session – may be avoided when using the present invention (Specification, p. 12, lines 18 - 19). The user may also experience less distraction by having fewer IM windows popping up on his display when using the present invention. Specification, p. 12, lines 18 - 21. See, for example, **Figs. 1 - 3**. In contrast to the cluttered display **100** of **Fig. 1**, where a prior art approach pops up new windows illustrated at **120**, **130**, and **150** for each new IM session, **Fig. 2** illustrates the display of icons in an already-open window **200** according to the present invention, where these icons are placed in already-open window **200** because an instant message arrives while any of the listed applications is/are executing. Specification, p. 12, lines 18 - 21. **Fig. 3** shows an alternative approach to window **200**, where icons **300**, **310** of **Fig. 3** are added to an already-displayed buddy list or status window that lists several IM partners and partner groups (Specification, p. 13, lines 1 - 4).

5.2.4. Claim 29 further states that the icon that is added to the already-open window is added in association with a representation of the IM sender (i.e., the sender of the newly-arriving instant

message which caused the icon to be added; Claim 29, lines 26 - 27; Specification, p. 17, lines 16 - 18), and that this icon visually indicates that the instant message is available for on-request display and can be activated to cause this on-request display (Claim 29, lines 28 - 30; Specification, p. 12, lines 15 - 18 and p. 13, lines 14 - 15). See **Figs. 2 and 3**, where the icons are shaped as an envelope and are depicted “in association with” a name of the instant message sender.

6. Independent Claim 28 includes means plus function terminology. Structure, material, or acts supporting this terminology are described in Appellants’ specification, as will now be described.

7. With regard to the “means for defining ... policy information ...” element on lines 3 - 7 of independent Claim 28, see reference numbers **500, 510** of **Fig. 5** and corresponding text on p. 17, line 9 - p. 18, line 9 and p. 20, lines 3 - 6 (referring, by way of example, to rules stored in a repository). The “means for receiving ...” element on lines 8 - 9 of Claim 28 is described on p. 12, lines 14 - 16 and p. 20, lines 12 - 15 (discussing an inbound message, to be received with the user’s IM system; examples of IM systems are stated on p. 2, lines 7 - 10). The “means for programmatically determining ...” element on lines 10 - 12 of Claim 28 is described on p. 12, lines 7 - 9; p. 20, lines 10 - 15 state that an inbound message [arrival] triggers evaluation of policy/rules information (including whether to pop up a new window or display an indication in an already-open window). The “means for responding ...” element on lines 13 - 17 of Claim 28 is described on p. 12, lines 1 - 2 (referring to configuring an instant messaging system to programmatically

respond). See also p. 20, lines 3 - 6, referring to storing rules in a data repository. In a general sense, see also the discussion on p. 23, line 19 - p. 24, line 7, discussing implementation using hardware, software, a combination of hardware and software, a computer program product embodied on computer-readable storage media, etc.

**REMARKS**

As noted above, a replacement **SUMMARY OF CLAIMED SUBJECT MATTER** is provided herein, and this replacement **SUMMARY** is to be substituted for the **SUMMARY** in Appellant's Appeal Brief filed on November 13, 2007.

Appellants respectfully submit that this replacement **SUMMARY** addresses the concerns noted in the **Notification of Non-Compliant Appeal Brief** mailed on November 29, 2007.

The Examiner is respectfully requested to contact the undersigned Appellants' representative if any further information is deemed necessary.

Respectfully submitted,

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